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OFFICE OF PETITIONS

In re Application  
Fumitoshi Asai et al.  
Application No. 10/600,266  
Filed: June 20, 2003  
Attorney Docket No. **17620-105003**

: DECISION ON APPLICATION  
: FOR PATENT TERM ADJUSTMENT

This is in response to the PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R § 1.705(b) filed November 19, 2010. Applicant requests that the determination of patent term adjustment be corrected from 285 days to 325 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and is being considered in light of the Court of Appeals for the Federal Circuit's decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for

continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

With respect to the over 3 year calculation, rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is DISMISSED.

On August 20, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 285 days. The instant application for patent term adjustment was timely filed<sup>1</sup> on or before payment of the issue fee.

With respect to the patent term adjustment at the time of the mailing of the notice of allowance, applicants acknowledge the period of adjustment of 404 days for Office delay. Applicants argue however that in response to a Final Office Action mailed on March 6, 2006, they filed an amendment on May 6, 2006 and further, in response to an Advisory Action mailed May 26, 2006, filed a Request for Continued Examination (RCE) along with a one month Request for Extension of Time. Applicants argue therefore that the papers submitted on May 6, 2006 fulfilled the requirements for a reply to an action by the USPTO under Rule 1.704(b) within the requisite three-month period and thus, does not incur any Applicant delay. Further, Applicants argue that a second three-month period for Applicants to submit a reply was triggered by the Advisory Action dated May 26, 2006, which expired after the RCE was filed.

At the outset, a response that receives an advisory action after final is not treated as a response with an omission. Rather, the time period under 37 CFR 1.704(b) continues to run until a sufficient response, such as the RCE in this matter, is filed. Furthermore, a second period for reply is not triggered by the mailing of the advisory action as the

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<sup>1</sup> PALM records indicate that the issue fee was paid on November 19, 2010.

advisory action mailed May 26, 2006 explicitly states that the period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

In this instance, as the amendment filed May 6, 2006 was not sufficient, the period for reply to the final rejection continued to run. The proper reply, the RCE, was not received in the Office until July 6, 2006. Thus, pursuant to § 1.704(b), the patent term adjustment has been properly reduced by 30 days for applicant delay from June 6, 2006 to July 6, 2006, the date of filing of the RCE.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.



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